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Remarks

Reconsideration of the above-captioned application is respectfully requested. All pending claims (1-22) have been rejected as being anticipated by Landsman et al. and as being unpatentable over Jacobs et al. in view of Landsman et al. It is noted that the last amendment of Claims 1 and 14, changing various recitations of "tag" and "advertisement" from the singular to the plural, failed to properly show score outs of the singular where appropriate, as is plain from reading the claims. Accordingly, this amendment drops the words in Claims 1 and 14 that should have been scored out in the last amendment as though they had been properly marked.

To overcome the present rejections, independent Claim 1 now recites allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display, as disclosed on, e.g., page 7, second full paragraph. Independent Claim 7, on the other hand, now specifies that the server is a Web server, unlike the email system of Jacobs et al., while independent Claim 14 has been amended to recite not just that the user accesses saved ads, but rather may affirmatively select saved ads from the ad history window. Claims 1-22 remain pending.

Rejections Under 35 U.S.C. §102

Claims 1-22 have been rejected under 35 U.S.C. §102 as being anticipated by Landsman et al., which teaches downloading advertisements to a user computer using an applet and then automatically playing multimedia content associated with the advertisements on the user computer during "interstitial" intervals (intervals between web page transitions), to free the user from any action whatsoever in displaying the advertisements, col. 10, lines 55-60; col. 11, lines 3-15; col. 39, lines 59-67. In other words, Landsman et

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al. automatically displays advertisements in the periods when the user clicks from one Web page to another, using the AdController agent relied on by the examiner. Thus, unlike Claims 7 and 14, the user of Landsman et al. cannot "select" an ad; rather, one is selected for the user, beyond user control, as the user navigates around the Web. Accordingly, Claims 7 and 14 can no longer be interpreted to cover Landsman et al., since they positively recite allowing a user to "select" an ad, something that Landsman et al. decidedly does not do.

Nothing in Landsman et al. teaches allowing a user to filter ads as now set forth in Claim 1.

It continues to be alleged that Landsman et al. "inherently" encompasses "the method of viewing" of Claims 20-22 in that this is "inherent" in Landsman et al.'s browser. The point the examiner is missing (but most assuredly that the Board will not) is that Claims 20-22 do not simply recite browser navigation aids in a vacuum; rather, they positively recite navigation through something that currently is not provided in any browser the examiner can identify, namely, an ad history window.

Accordingly, the anticipation rejections have been overcome.

Rejections Under 35 U.S.C. §103

Claims 1-22 have been rejected under 35 U.S.C. §103 as being unpatentable over Jacobs et al. in view of Landsman et al. The rejection is traversed on the following grounds.

As admitted by the Examiner, Jacobs et al. fail to disclose any particulars of an ad history window. Landsman et al. has been used for this shortfall but as shown above Landsman et al. has no such thing as an ad history window, and in fact the Examiner admits as much by weakly observing that Landsman et al. simply displays ads. Yes it does, but not in a separate ad history window. Note that examiners do not have

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free rein to give claim terms any broad meaning that happens to fit a rejection, but rather examiners may construe claims only as broadly as those skilled in the art would interpret them, MPEP §2111.01. No evidence has been adduced of record that the skilled artisan equates the banner ad display of Landsman et al. with an "ad history window", depriving the *prima facie* case of obviousness of legitimacy under the MPEP.

Since Landsman et al. does not make up for the admitted shortfall in Jacobs et al., the references even if combined as proposed would not arrive at the present claims.

Further, Jacobs et al. is directed to an email system. It has not been shown that Jacobs et al. enables its invention for use with Web-derived ads.

Additionally, the proffered suggestion to combine fails to comply with MPEP §2143.01, in that no *prior art* support for the suggestion has been identified, and moreover the proffered suggestion runs counter to the teachings of the references. All the proffered suggestion has to say is that it would have been obvious to combine the two references "to provide a user-friendly and commonly available system for viewing saved advertisements". But Landsman et al. does not have a "user-friendly" system for viewing saved ads; the ads in Landsman et al. are pushed onto the user by the AdController agent whether the user wants them or not.

As importantly, nothing in Jacobs et al. suggests that it requires a modification to use a system such as Landsman et al.'s, since Jacobs et al. is directed to an email system that works just fine without a Web advertising system like Landsman et al.'s. Consequently, the skilled artisan would have no motivation, on the basis of Jacobs et al., to combine it with Landsman et al. Moreover, nothing in Landsman et al. suggests application to an email system. Consequently, the skilled artisan would have no motivation, on the basis of Landsman et al., to combine it with Jacobs et al. Furthermore, no evidence has been adduced of record that

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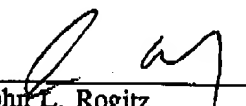
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it is common knowledge in the art to combine Web advertising agents such as the AdController agent disclosed in Landsman et al. with email systems such as that described in Jacobs et al. Thus, on its face, lacking as it does any prior art support, the suggestion to combine Jacobs et al. with Landsman et al. fails to comply with the requirements of the MPEP for making a *prima facie* case of obviousness. Moreover, on the evidence of record the proffered suggestion to combine in fact appears to have no support from either the prior art or the general knowledge in the art, see In re Dembiczak, 175 F.3D 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (the range of sources available does not diminish the requirement for actual evidence, and "broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence").

In addition to the above deficiencies, the rejections under this section of all 22 claims are confined to a single short paragraph. No claims are treated by claim number, much less has a case of obviousness been attempted to be made for any dependent claim. It is thus the kind of blanket rejection specifically prohibited by MPEP §707.07(d), last paragraph.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,



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